

Appl. No.: 09/973,244
TCA/U.: 1732 Docket No.: B01-31
Reply to Office Action of September 21, 2004

REMARKS

Claims 1-4, and 16-18, appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to recite the extruding step to form an extrudate and the cutting of the extrudate to form a preform. Also claim 1 has been amended to indicate in the independent claim the use of at least one laser micrometer for measuring. Support for the amended element(s) is found in the cancelled claims 6-8.

Claims 2-4 have been amended to correct some typo errors and to provide proper antecedent basis for the elements.

Claims 16-18 have been amended to provide proper dependency upon the base claim 1.

Claims 5-15 and 19-30 have been cancelled without prejudice to Applicants' right to file one or more continuing applications directed to any subject matter not presently claimed.

No new matter has been added by these amendments and additions.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-4 were rejected under 35 U.S.C. § 112, second paragraph.

The Examiner rejected claim 1 for the phrase "the predetermined standard preform volume" as on line 8, not having antecedent basis in the claim, but actually the antecedent basis is on lines 5-6 of the claim and has been incorporated into the amended claim 1.

Claims 3 and 4 were amended to have them depend upon claims 2 and 3 respectively in order that they have proper antecedent basis.

The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Appi. No.: 09/973,344
TC/A.U.: 1732 Docket No.: 891-31
Reply to Office Action of September 21, 2004

35 U.S.C. § 103(a) Rejection Over Schenk In View of Harris

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,085,937 issued to Schenk in view of U.S. Patent No. 4,209,476 to Harris. Schenk is generally directed to a conventional controlled volume positioning apparatus and does not discuss any measurement tools to maintain a controlled volume portioning. Schenk relies upon flow rate meters which would be nearly impossible with the nature of the core stock used in the Applicants' invention. Harris uses volumetric flow rate when fed into an intruder and computes linear speed of the extrudate to calculate cross sectional area, which is then compared to a predetermined reference within an automated process control system to automatically make adjustments to volumetric flow to maintain the preferred reference for cross sectional area. Thus Harris does not address preform volume, but a volumetric flow rate. A purpose of the present invention is to avoid this method.

The present invention uses at least one laser micrometer to measure each preform, and while it is conceded by the Applicants that laser micrometers are not new, it must be appreciated that they are new in the process of making golf ball cores. There is a lack of prior art teaching the measurement of an actual preform volume (one that focuses on the preform itself), and not a flow rate or some other correlating type measurement. When a preform is measured and is outside the established tolerance levels, the process automatically corrects the cutting of the extrudate. This is a far more accurate method. When a process must rely on controlling flow rates to control the preform volume, then there are too many variables being introduced. The present invention measures a finished preform and uses that data to control the size of the extrudate that is cut. This is not addressed in the prior art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Appl. No.: 09/973,344
TC/A.U.: 1732 Docket No.: B01-31
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Harris fails to cure the deficiencies of Schenk. There is no motivation to modify the references or any reasonable expectation of success in their combination.

Additionally, neither references, alone or in combination, discloses the measurement of a finished preform and coordinating this data to control the cutting of the extrudate as now recited in claim 1 of the present invention.

Moreover, the remaining claims 2-4 depend from claim 1 discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claim.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicants respectfully request reconsideration and withdrawal thereof.

35 U.S.C. § 103(a) Rejection Over Schenk In View of Harris

Claims 5-8, 12-14, and 16-18 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,085,937 issued to Schenk in view of U.S. Patent No. 4,209,476 to Harris.

Claims 5-15 have been cancelled however the concepts of claims 6 and 8 have been incorporated into the rewritten claim 1. The applicants must disagree with the Examiner's statement that the use of a laser micrometer is a mere obvious matter of choice. It is the combination of the micrometer and using the measurements thus obtained to control the subsequent cutting of extrudates. This is not found in the golf industry and the means of Harris would not work in this process, therefore not supporting or modifying Schenk to the necessary degree that would be required.

Claims 16-18 depend from claim 1 discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claim. The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicants respectfully request reconsideration and withdrawal thereof.

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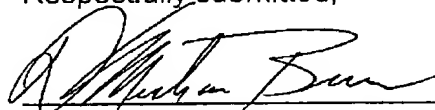
Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

Other than an extension of time petition for a one (1) month extension, no additional fees are believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

January 17, 2005
Date


D. Michael Burns (Reg. No. 38,400)
(508) 979-3563

Customer Number: 40990